

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number <b>Q60535</b>
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number <b>09/832,828</b>	Filed <b>April 12, 2001</b>
	First Named Inventor <b>Michal KAHAN</b>	
	Art Unit <b>2179</b>	Examiner <b>Sara M. HANNE</b>
	<div style="text-align: center;"> <small>WASHINGTON OFFICE</small>  <b>23373</b>  <small>CUSTOMER NUMBER</small> </div>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s).  Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number <u>52,800</u>                      <u>/Scott H. Davison/</u>  <div style="text-align: right;">Signature</div></p> <p style="text-align: right;"><u>Scott H. Davison</u>  Typed or printed name</p> <p style="text-align: right;"><u>(619) 238-3545</u>  Telephone number</p> <p style="text-align: right;"><u>July 25, 2008</u>  Date</p>		

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q60535

Michal KAHAN, et al.

Appln. No.: 09/832,828

Group Art Unit: 2179

Confirmation No.: 1955

Examiner: Sara M. HANNE

Filed: April 12, 2001

For: METHOD AND APPARATUS FOR INFORMATION AGGREGATION AND  
PERSONALIZED DISPLAY OF THE AGGREGATED INFORMATION

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated January 25, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue. The Examiner twice rejected claims 1-4, 7, 8, 11, 14-17, 19-23, 26-29, 31, 34-41, 43-45 and 47-53, are rejected under 35 USC 103(a) as allegedly being unpatentable over Kim, US Patent 6,546,002 (hereinafter "Kim"), and further in view of McNamar et al., US Patent 7,089,202 (hereinafter "McNamar"). See Office Action of January 25, 2008.

The sole question on appeal is whether the rejection of all claims under 35 USC §103 as being unpatentable over the combination of Kim and McNamar is correct. The Applicant

submits that the Examiner errs in rejecting claims 1-4, 7, 8, 11, 14-17, 19-23, 26-29, 31, 34-41, 43-45 and 47-53 as being obvious in view of Kim and McNamar.

The inventions embodied in the pending claims are directed to a method and apparatus for integrating mobile data services and content sources and aggregating information from those sources into a dynamic, personalized format for a mobile subscriber. Specifically, the invention described in the pending claims aggregates personalized information and services as requested by a subscriber, and then permits the subscriber to aggregate the content into menus that do not require the conventional menus associated with mobile applications.

As set forth in the claims, the method and apparatus pertain to aggregating data from content providers and delivering that data to a mobile subscriber on a mobile terminal. A server transmits a provisioning profile associated with the subscriber to the content providers that are running outside applications, and the content providers then push data items back to the server. The data items contain personalized information to be pushed out to the mobile terminal according to the provisioning profile associated with the subscriber. The data items are then arranged at the server in accordance with subscriber-selected presentation rules, where it is then pushed out to the subscriber's mobile terminal for display on the mobile terminal. Each data item is associated with at least one of the subscriber-selected presentation rules. Further, each data item is associated with a generic action menu, an application specific menu or both.

**A. No Motivation to Combine Kim and McNamar**

The Applicant contends that the Examiner has failed to establish a *prima facie* case of obviousness for combining Kim and McNamar, because neither Kim nor McNamar provide any teaching, suggestion or motivation to combine their teachings to produce the claimed invention.

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As admitted by the Examiner in the Office Action of January 25, 2008, “obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” *Office Action of January 25, 2008*, p. 8 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). The Examiner then states that “one of ordinary skill in the art would see the advantage of including the push technology of McNamar in a wide array of technologies.” *Id.*, p. 8. This argument, however, is merely conclusory, and does not provide any reference in either McNamar or Kim that discusses the requisite “teaching, suggestion or motivation” to combine the teachings to arrive at the claimed invention.

Kim, classified in class 370, subclass 351 of “Multiplex Communications—Pathfinding or Routing,” is directed to a system and method for using a mobile interface agent “that allows the user to access documents, files, programs, applications, URL bookmarks, IP addresses, telephone numbers, television channels, radio stations, and other menu items from any computer.” *Kim, Abstract*. McNamar, on the other hand, is classified in class 705, subclass 35, of “Data Processing: financial, business practice, management or cost/price determination—Finance.” McNamar is directed to a “Method and System for Internet Banking and Financial Services,” and specifically to a “method of providing a client with an integrated financial management account.” *McNamar, Title and Abstract*.

The Applicant submits that Kim and McNamar are wholly unrelated in subject matter and technology, and one skilled in the art would not be motivated to combine the teachings of a

mobile interface agent with a method for Internet banking to arrive at the claimed invention. As the Supreme Court recently affirmed, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Co. v. Teleflex*, 127 S. Ct. 1727, 1741 (2007). Further, the Examiner cites to no section in either McNamar or Kim that would suggest the desirability of the modification of push technology, only cursorily discussed in McNamar, with the mobile interface agent in Kim.

The Examiner states that “one would have been motivated to make such a combination because a way to provide pre-selected information to the user when it becomes available would have been obtained, as taught by McNamar.” *Office Action of January 25, 2008*, p. 4. The Examiner again provides only conclusory statements, and does not provide any teaching, suggestion or motivation in Kim or McNamar that discusses the use of push technology for aggregating data from content sources to be delivered to a mobile terminal, as described in the claimed invention.

For at least these reasons, the Applicant submits that there is no motivation to combine the teachings of Kim and McNamar to arrive at the claimed invention, and therefore submits that the rejection under 35 USC §103 is improper.

**B. Examiner Fails to Provide a Sufficient Rationale for the Asserted Combination**

The Applicant contends that the Examiner has failed to establish a *prima facie* case of obviousness for combining Kim and McNamar, because the Examiner has not provided a sufficient rationale for the asserted combination of references.

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To establish a prima facie case of obviousness, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does...” *KSR* at 1741. The Examiner’s “analysis should be made explicit” and “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* In discussing “the apparent reason to combine the known elements in the fashion claimed,” the Examiner must provide a detailed explanation of “the effects of demands known to the design community or present in the marketplace,” especially “the background knowledge possessed by a person having ordinary skill in the art.” *Id.* at 1740-1741.

The Applicant submits that the Examiner’s analysis and rationale for the combination of Kim and McNamar is merely conclusory, and is not supported by the requisite “explicit analysis,” “articulated reasoning” or detailed explanation as to why the claimed invention is obvious in view of Kim and McNamar. Therefore, the Applicant submits that the Examiner has failed to establish a prima facie case of obviousness as required to sustain a rejection under 35 USC §103.

Respectfully submitted,

/Scott H. Davison/

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WASHINGTON OFFICE

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